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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,616	08/06/2001	Ryan Burkhardt	MS155709.1/4930	8312
321	7590	08/27/2004	EXAMINER	
SENNIGER POWERS LEAVITT AND ROEDEL ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			RUTTEN, JAMES D	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,616

Applicant(s)

BURKHARDT ET AL.

Examiner

J. Derek Rutton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-7, 14, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 3 suggests in lines 3-5 that "staging the programs includes copying an image of the reference system to the storage medium of the destination computer." However, it also suggests in line 3 that programs are staged on a reference system. The description of staging from lines 3-5 suggests that the reference computer is somehow also a destination computer since in order for programs to be staged on a reference system, they must be copied from another reference system.

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It is unclear whether the actual step of staging occurs on the reference system, or upon copying the reference image to the destination computer. It will be interpreted that a staging setup occurs on the reference system image, and that the term “staging” refers to copying a staged image to a destination computer.

5. Claims 4-7 are rejected for being dependent upon rejected base claim 3.
6. Claim 14 recites the limitation "the script" in line 2. There is insufficient antecedent basis for this limitation in the claim. However, claim 10 mentions use of a script. For the purpose of further examination, this claim will be interpreted as being dependent upon claim 10.
7. Claim 31 recites the phrase “a first data field including files...” in line 3. It is not clear if the word “includes” should imply that a file is physically included in the data field, or if this should suggest a list of files. As interpreted from page 14 of the originally filed specification, this limitation will be interpreted to suggest a list of files.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 31 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 31, merely claimed as “a computer-readable medium having stored thereon a data structure”, constitute non-functional descriptive material *per se*. The claims do not define any structural and functional relationship between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. The claimed data structure is not capable of causing functional change in a computer.

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Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760. Note that while Applicant's claims recite a "data structure", the recited limitations do not impart functionality when employed as a computer component and do not specify a physical or logical relationship among data elements, designed to support specific data manipulation functions. Accordingly, the claimed matter cannot be considered functional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 10, 11, 13-15, 18-23, 25, 28, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,794, 052 to Harding (hereinafter "Harding").

As per claim 1, Harding discloses:

A computerized method of installing programs on a destination computer (column 113 lines 2-40), said method comprising:

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staging one or more programs on a storage medium of the destination computer

(column 10 lines 36-40: "Typically, software program modules are downloaded from the mass data storage device 200 to the hard disk drive 310 via a parallel port connection, or a network connection between the mass data storage device 200 and the computer system 300.");

selecting at least one of the staged programs for installation on the destination

computer (column 13 lines 8-10: "The software setup program also prompts the end user to select a language keyboard configuration."); *and*

attaching the selected program to complete the installation thereof on the

destination computer (column 13 lines 29-31: "At this point, the software setup program simulates the method of software installation used by the computer manufacturer when preparing computer systems for the U.S.").

As per claim 2, the above rejection of claim 1 is incorporated. Harding further discloses: *detaching any of the programs not selected for installation on the destination computer* (column 5 lines 11-16. Unused modules are detached when selected modules are copied to the destination.).

As per claim 3, the above rejection of claim 1 is incorporated. Harding further discloses: *further comprising defining a reference system, said reference system comprising a computer that has an operating system installed thereon and the one or more programs staged thereon* (column 4 lines 57-60), *and wherein staging the programs includes copying an image of the reference system to the storage medium of the destination computer* (column 5 lines 32-35).

As per claim 10, the above rejection of claim 1 is incorporated. Harding further discloses: *wherein attaching the selected programs includes performing one or more functions on the destination computer according to a customizable script* (column 5 lines 30-45).

As per claim 11, the above rejection of claim 10 is incorporated. Harding further discloses: *wherein the script is a text-based configuration file* (column 5 lines 35-38 describe use of a BAT file which is well known to be text-based.).

As per claim 13, the above rejection of claim 10 is incorporated. Harding further discloses: *wherein the script defines an order in which the selected programs are to be attached* (column 5 lines 38-43).

As per claim 14, the above rejection of claim 10 is incorporated. Harding further discloses: *wherein attaching the selected programs includes executing an installation*

command routine according to the script (column 5 lines 35-37).

As per claim 15, the above rejection of claim 1 is incorporated. Harding further discloses: *wherein the programs include either application programs, utility programs, or both (column 5 lines 3-16).*

As per claim 18, the above rejection of claim 1 is incorporated. Harding further discloses: *A computer readable medium having computer-executable instructions (column 5 lines 17-20).*

As per claim 19, Harding discloses:

A system for configuring a computer (FIG. 2) comprising:

a reference computer including a storage medium, said storage medium of the reference computer having an operating system installed thereon and one or more programs staged thereon, said storage medium of the reference computer defining a reference image (column 4 lines 57-59: "Each device driver and application, or module, that is available for downloading is installed onto a computer system one by one.");

a destination computer including a storage medium and a processor, said reference image being copied to the storage medium of the destination computer (column 6 lines 16-18: "Prior to shipping, the computer manufacturer

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installs modules of DOS and Windows for every available language desired as an option."); and

a computer-readable medium having computer-executable instructions identifying at least one of the staged programs for installation on the destination computer, said processor of the destination computer executing the instructions to attach the identified program to complete the installation thereof on the destination computer (column 6 lines 47-54: "The language specific batch file acts as a "hook" which connects the software setup process of providing the end user a selection of languages to the software installation process which installs the software using the modular method described previously. Thus, once the software setup program runs the language specific batch program, the software setup program performs a series of steps similar to those performed by the software installation program.").

As per claim 20, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 2.

As per claim 21, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 10.

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As per claim 22, the above rejection of claim 21 is incorporated. All further limitations have been addressed in the above rejection of claim 11.

As per claim 23, the above rejection of claim 21 is incorporated. All further limitations have been addressed in the above rejection of claim 13.

As per claim 25, the above rejection of claim 21 is incorporated. All further limitations have been addressed in the above rejection of claim 14.

As per claim 28, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 15.

As per claim 31, Harding discloses:

A computer-readable medium having stored thereon a data structure (column 5 lines 17-25) comprising:

a first data field including files associated with a plurality of staged programs
(column 5 lines 28-42: "Once all of the module files, including its associated script file, are exploded and downloaded onto the hard disk drive, the FIX\$FILE.BAT program runs the batch files associated with each installed module in the order that the modules are downloaded."),

said programs being staged on the computer-readable medium for installation on a destination computer associated with the computer-readable medium (column 10 lines 36-40: "Typically, software program modules are downloaded from the mass data storage device 200 to the hard disk drive 310 via a parallel port connection, or a network connection between the mass data storage device 200 and the computer system 300."); *and*

a second data field including a configuration script for directing the destination computer in performing one or more functions (column 5 lines 45-50: "The SCRIPT.EXE and associated module script files are programmed such that the execution of each module's script file by the SCRIPT.EXE program implements the changes required by that particular module to the appropriate configuration files and directories, in order to make that module work properly."),

said script being customizable for identifying at least one of the staged programs for installation on the destination computer (column 5 lines 30-45: "The way in which the script files automatically implement changes to the configuration files is as follows. In a preferred embodiment, a software installation program, called a Hard Disk Master (HDM) program, is loaded onto the hard disk drive along with all of the modules necessary to fulfill a

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specifically requested configuration. The software installation program runs a batch program called FIX\$FILE.BAT and an execution program called SCRIPT.EXE. Once all of the module files, including its associated script file, are exploded and downloaded onto the hard disk drive, the FIX\$FILE.BAT program runs the batch files associated with each installed module in the order that the modules are downloaded. The module batch files include an instruction to run the SCRIPT.EXE program. The SCRIPT.EXE program executes the script file associated with that module.”).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-7, 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding as applied to claims 3, 10, and 21 above, and further in view of “Microsoft Windows 2000 Server Unleashed” by Brown et al. (hereinafter “Brown”).

As per claim 4, the above rejection of claim 3 is incorporated. Further, Harding does not expressly disclose: *performing one or more functions on the reference system computer according to a customizable script*. However, in an analogous environment, Brown teaches the installation of an operating system according to a customizable script (Chapter 3, “Automated Installation”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Brown’s customizable script in Harding’s reference system. One of ordinary skill would have been motivated to save time by automating a setup process.

As per claim 5, the above rejection of claim 4 is incorporated. Harding discloses a text-based configuration file (column 5 line 36. BAT files are known to be text-based.)

As per claim 6, the above rejection of claim 4 is incorporated. Further, Harding discloses a script file that contains identification of file locations (column 4 line 64 – column 5 line 1).

As per claim 7, the above rejection of claim 4 is incorporated. Further, Harding discloses: *wherein the script defines an order in which the programs are to be staged* (column 11 lines 1-4).

As per claim 12, the above rejection of claim 10 is incorporated. Harding further discloses: *wherein the script identifies which of the staged programs are to be attached*

(column 10 lines 64-67). Harding does not expressly disclose a script that identifies which of the staged programs are to be detached.

However, Brown discloses a script with predetermined answers to installation questions (Chapter 3: "answer file"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Brown's predetermined answers in Harding's script. One of ordinary skill would have been motivated to provide an unambiguous list of software that is available and that should or should not be installed.

As per claim 24, the above rejection of claim 21 is incorporated. All further limitations have been addressed in the above rejection of claim 12.

14. Claims 8, 9, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding as applied to claim 1 above, and further in view of "Windows 95 Installation and Configuration Handbook" by Tidrow et al. (hereinafter "Tidrow").

As per claim 8, the above rejection of claim 1 is incorporated. Harding further discloses: *wherein staging the programs includes copying files associated with the programs to the storage medium of the destination computer without storing configuration data associated with the programs* (column 10 lines 47-54 and column 5 lines 45-50). Harding does not expressly disclose *wherein the destination computer has a registry for storing configuration data*.

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However, in an analogous environment, Tidrow teaches an operating system that has a registry for storing configuration data (page 407 "Using the Registry"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Tidrow's teaching of a registry to store the configuration files of Harding. One of ordinary skill would have been motivated to consolidate the various configuration files into a single database for easier and more efficient storage and retrieval of configurations and settings.

As per claim 9, the above rejection of claim 8 is incorporated. Harding further discloses: *wherein attaching the selected programs includes storing configuration data associated with the selected programs* (column 5 lines 45-50). All further limitations have been addressed in the above rejection of claim 8.

As per claims 26 and 27, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejections of claims 8 and 9, respectively.

15. Claims 16, 17, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding as applied to claim 1 above, and further in view of Brown in view of the "Background of the Invention" section appearing in columns 1-4 of Harding (hereinafter "Harding's background").

As per claim 16, the above rejection of claim 1 is incorporated. Harding further discloses:

executing a first installation utility on a reference computer (column 4 lines 59-64);

controlling the first installation utility to stage the one or more programs on a storage medium of the reference computer (column 5 lines 17-25);

Harding does not expressly disclose: *controlling the first installation utility according to a first configuration script; installing an operating system on the reference computer using the installation utility; defining a reference image of the storage medium of the reference computer having the operating system installed thereon and the one or more programs staged thereon; and copying the reference image to the destination computer.*

However, in an analogous environment, Brown teaches controlling an installation utility according to a configuration script (Chapter 3: "UNATTEND.TXT"), and installing an operating system using an installation utility (Chapter 3: "Automated Installation"). Also, Harding's background teaches that reference images containing an operating system of a reference system can be copied to a destination computer (column 1 line 61 – column 2 line 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Brown's installation utility and configuration script along with Harding's background teaching of reference images in Harding's system. One of ordinary skill would have been motivated to maintain a reference image that can be

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packaged and distributed to computers that may not have direct access to a reference computer. A reference image allows a custom distribution of software modules to be selected and installed on a destination computer.

As per claim 17, the above rejection of claim 16 is incorporated. Harding further discloses:

*executing a second installation utility on the destination computer; and
controlling the second installation utility according to a second configuration script to
attach the selected program on the destination computer (column 5 lines 35-45).*

As per claims 29 and 30, the above rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejections of claims 16 and 17, respectively.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (703) 605-5233. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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jdr



TUAN DAM
SUPERVISORY PATENT EXAMINER